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Paper No. 15  
PTH

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re **Milano Hat Company, Inc.**

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Serial No. 75/199,345

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**Alan W. Lintel** of Anderson, Levine & Lintel, L.L.P. for  
**Milano Hat Company, Inc.**

**Sharon Asar**, Trademark Examining Attorney, Law Office 102  
(**Thomas Shaw**, Managing Attorney).

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Before **Hairston**, **Bucher** and **Bottorff**, Administrative  
Trademark Judges.

Opinion by **Hairston**, Administrative Trademark Judge:

An application has been filed by the Milano Hat  
Company, Inc. to register the composite mark MILANO HATS  
and design, as shown below for "western hats and caps."<sup>1</sup>

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<sup>1</sup> Serial No. 75/199,345 filed November 18, 1996, based on an  
allegation of a bona fide intention to use the mark in commerce.  
The word "HATS" and the pictorial representation of Italy have  
been disclaimed apart from the mark as shown.



Registration has been refused under Section 2(a) of the Trademark Act on the ground that the mark is geographically deceptive.<sup>2</sup> It is the Examining Attorney's position that if applicant were to use this mark on the identified goods, purchasers would mistakenly believe that the goods originate in Milan, Italy, and that this

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<sup>2</sup> The Examining Attorney also initially refused registration under Section 2(e)(3) of the Trademark Act on the ground that the mark is geographically deceptively misdescriptive. In response thereto, applicant submitted a declaration under Section 2(f) of the Act claiming that the mark had acquired distinctiveness as a result of over fourteen years use. Further, applicant asserted that the mark had become distinctive prior to December 8, 1993, the date of enactment of the North American Free Trade Agreement. The Examining Attorney subsequently withdrew the Section 2(e)(3) refusal. We consider the Section 2(a) and 2(e)(3) refusals to be alternative refusals. Thus, if we find that the mark is not geographically deceptive under Section 2(a), it may be registered pursuant to the provisions of Section 2(f).

misunderstanding would be a material factor in the purchasing decision.

Applicant has appealed. Briefs have been filed, but no oral hearing was requested.<sup>3</sup>

The test for determining whether a mark is geographically deceptive under Section 2(a) is set forth in *Institut National des Appellations D'Origine v. Vitners International Co., Inc.*, 958 F.2d 1574, 22 USPQ2d 1190, 1195 (Fed. Cir. 1992). The elements are as follows:

1. Whether the primary significance of the mark as it is used is a generally known geographic place;
2. Whether purchasers are likely to believe, mistakenly, that the goods or services sold under applicant's mark have their origin in or are somehow connected with the geographic place named in the mark and, if so;
3. Whether a purchaser's mistaken belief as to the geographic origin of the goods or services would materially affect that purchaser's decision to buy the goods or services sold under the mark.

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<sup>3</sup> We note that the Board, in a decision issued March 27, 2002, affirmed the Examining Attorney's refusal to register, under Sections 2(e)(2) and 2(a) of the Act, applicant's composite mark MILANO and design for western shirts (Serial No. 75/199,511).

At the outset, we note that applicant is incorporated in the state of Texas and has indicated that its western hats and caps will not be manufactured or produced in Milan, Italy. Further, there is no dispute that the term "Milano" is Italian for the city of Milan in Italy.<sup>4</sup>

In urging reversal of the refusal to register, applicant argues that the primary significance of the term Milano is not geographic. Rather, applicant maintains that the primary significance of Milano is as a surname, and that applicant selected the applied-for mark because of the surname of its founder, John Milano, and not because of any

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<sup>4</sup> In this regard, the Examining Attorney submitted an entry from Webster's New Geographical Dictionary (1988), the relevant portion of which is reproduced below:

**Milan** \mə-'lan, -'län\ or *Ital.* **Mi-la-no** \mə-'län-(j)ə\ or *anc. Medi-a-lanum* \mēd-ā-δ-'län-am, med-\ **Commercial and industrial commune, \* of Lombardy and of Milano prov., N Italy, 76 m. NE of Genoa in a fertile plain between Adda and Ticino rivers; pop. (1981p) 1,634,638; archiepiscopal see; principal financial center of Italy; produces machinery, textiles (esp. silk), chemicals, motor vehicles, clothing; numerous notable buildings, including white-marble cathedral (begun 1387, completed 1858), 3d largest in Europe; castle, amphitheater, triumphal arch, basilica of St. Ambrose (4th cent., restored), royal and archiepiscopal palaces, Brera palace (incl. Brera art gallery), Ambrosian library (earliest public library in Europe), La Scala theater, Ospedale Maggiore (1456, first municipal hospital); Univ. of Milan (1924), technical institute (1863).**

desired connection with Milan. According to applicant, because its founder is one of the best known figures in the hat industry, prospective purchasers of applicant's goods will associate the applied-for mark with applicant, the Milano Hat Company, and not the city of Milan.

Further, applicant maintains that western hats, in particular, are indigenous to the southwest United States, and that no appreciable number of western hats have ever been designed or produced in Milan. Applicant maintains that while Milan may be well known as a fashion center, it is not known for the design or production of western hats. In this regard, applicant offered the declaration of Clay Cavender, vice-president and head buyer of Cavender's Boot City, a chain of approximately forty western wear stores located throughout Texas. According to Mr. Cavender, Cavender's Boot City is one of the largest sellers of western wear products in the country. Mr. Cavender states that he is familiar with buyer preferences in relation to western wear and that he has purchased products from applicant for many years for sale in Cavender's Boot City stores. Further, Mr. Cavender states that to his knowledge, no customer has ever purchased or considered purchasing applicant's products sold under the same or similar mark involved herein under the impression that the

products had a connection with Milan; that customers of western wear prefer that such goods come from a company based in the southwest United States rather than from a company in a "high fashion" center such as Milan, Paris, London or New York; that almost all of the western wear vendors with whom he does business are based in the southwest United States, although some vendors manufacture their products elsewhere because of cost considerations; and that no significant number of consumers of western wear has been or will be deceived with regard to any geographic connection to Milan by applicant's mark as used on western hats.

With respect to caps, applicant argues that baseball caps, in particular, are indigenous to the United States and that they are generally associated with athletic teams and company promotions. Applicant argues, therefore, that prospective purchasers will not associate these kinds of goods with Milan.

Finally, applicant states that the star on the map of Italy in the drawing of its mark designates the city of Sorrento, which is located in the southern part of Italy, and is the birthplace of applicant's founder. Applicant maintains that there will be no deception in this case

because the star serves to negate any connection with Milan, which is located in the northernmost part of Italy.

It is the Examining Attorney's position that the primary significance of applicant's mark as a whole is the geographic place Milan, Italy. As noted previously, the Examining Attorney submitted a dictionary entry with regard to the term "Milano." The Examining Attorney acknowledges that the entire mark is more than the word MILANO.

However, the Examining Attorney notes that the term "HATS" is simply the generic name for applicant's goods and serves no source-identifying function. Moreover, the Examining Attorney argues that the pictorial representation of Italy in the drawing of the mark reinforces the geographic connotation of the mark as a whole.

Further, in view of the evidence of a goods/place association between clothing and Milan, and the fame of Milan as a fashion center, the Examining Attorney argues that the public will be likely to believe that applicant's goods come from Milan and this belief will materially affect the public's decision to buy applicant's goods. Also, the Examining Attorney argues that the city of Milan is especially associated with hats as evidenced by the

following definition of the word "milliner" taken from The American Heritage Dictionary of the English Language (3ed. 1992)[electronic version]:

**milliner** (noun): one that makes, trims, designs, or sells hats. [Probably alteration of Middle English *Milener*, native of Milan, from Milan, the source of goods such as bonnets and lace.

After careful consideration of the record herein and the arguments of the Examining Attorney and applicant, we find that purchasers would be likely to believe, mistakenly, that western hats and caps sold under applicant's mark originated in or were somehow connected with Milan. While it appears that the term "Milano" has some surname significance, the evidence of record demonstrates that the primary significance of the term is geographical. Applicant has presented no evidence that "Milano" is a common surname. Moreover, we agree with the Examining Attorney that the pictorial representation of Italy in the drawing of the mark reinforces the geographic connotation. Most American consumers would certainly recognize the pictorial representation as Italy and along with the word MILANO would make an association with Milan. On the other hand, we are not convinced that most Americans would know that the star is in the location of Sorrento, rather than Milan. Thus, contrary to applicant, we do not



find that the star negates any association with Milan. Also, in our minds, the lasso which surrounds the term MILANO and the pictorial representation of Italy does not detract from the geographic significance of the mark, but instead serves to convey that the goods are western in nature with a Milan origin or connection.

With respect to applicant's argument that customers will understand that MILANO in its mark refers to applicant and not the city of Milan, while customers who have some familiarity with applicant or its founder may well recognize this, our concern is not limited to these customers. Rather, we must concern ourselves with the purchasing public in general, and purchasers who are not familiar with either applicant or its founder would be free to make the association between the city of Milan and applicant's goods.

Turning then to the question of whether purchasers are likely to make a goods/place association between western hats and caps and Milan, we find that the Examining Attorney has submitted ample evidence to support such an association. In addition to the dictionary entry which indicates that Milan is a producer of clothing, the Examining Attorney submitted Nexis excerpts which demonstrate that, as applied to items of clothing, the

primary significance of Milan is geographical given Milan's reputation as a center of fashion apparel. Examples are set forth below.

Spurring Milan's growth as a high-fashion hub are a handful of design houses such as Krizia, Versace, and Ferre, whose ties to Italian textile giants give them global reach.

(Business Week; July 20, 1987);

Although no strangers to fashion - the word "millinery" comes from "Milaner" - the Milanese have become a major power in the the international fashion world in just the last decade. Fashion generates more than \$10 billion in sales for Italy, almost half of which comes from exports. Even the French, vaunted masters of the fashion world, come here to buy much of their fabric, as do many of America's top designers.

(Chicago Tribune; March 9, 1998);

Over the past decade, Milan has come to rival New York and Paris as one of the world's fashion centers.

(The Boston Globe; November 10, 1997); and

Okun is constantly at work with the company's customer base. And he travels all over to the world's fashion centers: Paris, London, Milan, attending all the important fashion shows and functions.

(Textile World; June 1996).

Further, the Examining Attorney made of record Nexis excerpts, which demonstrate that western wear, in particular, debuts or premieres in Milan.

Every few years, as faithfully as a Yellowstone geyser, fashion goes cowboy crazy. Rodeo gaga. Boots, hats, beadwork, fringe - the icons of Western mythology suddenly start appearing on the likes of Madonna and Kate Moss and in places far, far from the Santa Fe Plaza or Mesquite Rodeo . . . Although this may be the biggest year for Westernalia since the roundup of '88, the specifics have changed just enough to require that we all go shopping. Far from "Urban Cowboy's" boot-scootin' flash or "Lonesome Dove's" dusty drovers, the latest spin on Western is rooted not in Laramie or Dodge, but in New York, Paris and Milan.

(Pittsburgh Post-Gazette; September 19, 1999);

Last summer, fashion magazines targeting both men and women touted "Vegas chic"—fringed and beaded jackets, skirts and pants, for instance . . . as the style to mimic. The industry's affinity for all things Western carried over into the fall and winter, when people attending the fashion shows in New York, Paris and Milan turned out in dark denim outfits accented with scrunched cowboy hats and gleaming black boots.

Your father's suits, your son's cowboy boots, the animal skin rug in your den should form about the right inspirational mix for your fall fashion wardrobe, if the European shows have any say. In Milan, London and Paris, the world's top designers are going for menswear inspirations, American Western wear and animal prints in the clothes that will come here in many forms for fall and winter.

(The Boston Globe; March 23, 1992); and

"Here in Italy, I'm seeing a lot of big Western buckles, as well as exotic cowboy boots," said Julian by phone from a trend-

watching trip to Milan. The revival of the Western look as fashion fare is hitting in the high-end designer category, says Julian. (The Times-Picayune; January 16, 2001).

This record establishes Milan's prominence as a center of fashion, including western wear, and the public would be likely to believe that applicant's western hats originate in or are somehow connected with Milan. The declaration of Mr. Cavender does not rebut this prima facie case. While traditional customers of western wear may be knowledgeable about its origins and may even prefer that it come from companies located in the southwest United States, our concern is not limited to such individuals. There is no question that western wear is sold to the buying public at large, and that from time to time, western styles are in fashion. Thus, the average purchaser would be likely to believe, mistakenly, because of the association between Milan and clothing that applicant's western hats originate in or are somehow connected to Milan.

In addition, because applicant's identification of goods is not restricted as to any specific types of caps, it must be assumed that applicant will sell caps of all types; not only baseball caps.<sup>5</sup> This would necessarily

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<sup>5</sup> We should make clear that applicant has not argued that its identification of goods should be read to mean "western caps." Moreover, we are not aware of any such type of caps.

include stylish or dressy caps. Because of Milan's prominence as a fashion center, prospective purchasers would be likely to believe, mistakenly, that applicant's caps originated with or had some connection with Milan.

Moreover, even if applicant's identification of goods were limited to baseball caps, we would not be persuaded by applicant's argument that consumers would not believe its baseball caps originated from Milan because baseball caps are generally associated with athletic teams and company promotions. In today's market, baseball caps are emblazoned with cartoon characters, geographic names, and trendy expressions, among other things. We have no doubt that if a prospective purchaser were to encounter a baseball cap under applicant's mark with "Milan" emblazoned on the front of the cap, the purchaser would be likely to believe, mistakenly, that the baseball cap originated in or had some connection with Milan.<sup>6</sup>

The final question then is whether the geographical misdescription created by applicant's mark has been shown

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<sup>6</sup> In reaching our conclusion that purchasers are likely to make a goods/place association between western hats and caps and Milan, we accorded little weight to the dictionary entry for the word "milliner" made of record by the Examining Attorney. We do not believe the average American consumer is aware of the derivation of the word "milliner."

to be material to the purchase of western hats and caps bearing the mark. We find that it has. The evidence put forth by the Examining Attorney demonstrates the fame of Milan as a center of fashion and its reputation for fine quality and famous designers. Thus, there is no question that a Milan connection would more appealing or desirable to prospective purchasers, and thus, this factor would be material to the decision to purchase western hats and caps.

**Decision:** The refusal to register under Section 2(a) of the Trademark Act is affirmed.